

## REMARKS

Non-elected claims 28-31 and 35-45 have been canceled. Claim 23 has been amended to include the limitations of claims 26 and 27, which have been canceled. Claims 23 and 32-34 have been amended to correct antecedent basis and other formal issues. No new matter has been added. Upon entry of this amendment, claims 23-25 and 32-34 will be pending in this application.

The Examiner indicates that the Information Disclosure Statement filed on August 18, 2006, fails to comply with 37 CFR 1.98(a)(2) by not including four of the listed references. Applicants respectfully disagree. As evidenced by the attached PTO-stamped postcard receipt, which serves as *prima facie* proof of receipt of the documents listed thereon, Applicants provided the Office with the eight foreign patent documents listed on the PTO-1449 form filed on August 18, 2006. Of the four foreign patent documents lined through by the Examiner, two of them are available on PAIR (WO 01/60268 and EP 1 283 026 A2). Copies of the other two patent documents (WO 03/084449 and WO 2004/080316) are provided herewith for the Examiner's convenience. Applicants would appreciate the Examiner considering these documents, and indicating that the documents have been considered and made of record.

Claim 23 is rejected under 35 USC 112, second paragraph, as indefinite for reciting the actuating device, rather than the excavating element, as retracting in and protruding from the head part. Claim 23 has been amended to clarify that the excavating element is retracted in and protrudes from the head part. With the amendment to claim 23, it is respectfully submitted that the 35 USC 112 rejection of claim 23 has been overcome.

Claim 33 and 34 are rejected under 35 USC 112, second paragraph, as indefinite for lacking antecedent basis for "the actuating element." Claim 33 is further rejected as indefinite in relation to the recited bounds of the actuating element. Claims 33 and 34 have been amended to replace "actuating element" with "actuating device," and to clarify the recited bounds of the actuating device. With the amendments to claims 33 and 34, it is respectfully submitted that the 35 USC 112 rejection of claims 33 and 34 have been overcome.

Claims 23-27 and 32-34 are rejected under 35 USC 102(b) on Michelson (US 2003/0149484). The rejection is moot as applied to claims 26 and 27, which have been canceled. With the amendment to claim 23, it is respectfully submitted that the 35 USC 102 rejection of claims 23-25 and 32-34 has been overcome.

Claim 23 is directed to an instrument for implanting a cervical intervertebral prosthesis. The instrument has a handle, a stem and a head part. The head part includes an excavating element configured for creating a recess in a cranial-caudal direction in adjacent vertebral bodies for receiving the intervertebral prosthesis. Claim 23 has been amended to recite that the excavating element comprises pairs of cutting fins which are arranged opposite one another, and that the cutting fins of each pair have different heights relative to one another. These aspects are neither disclosed nor suggested by Michelson.

Support for these amendments can be found in at least FIGS. 4 and 5 and the corresponding parts of the specification (in particular, paragraphs [0047] and [0050] in the published application). For example, upon considering the distance that the tip of each fin can protrude out of head part 60, the height of fins 72 as shown in FIG. 4B is rather low relative to the much greater height of fins 71 as shown in FIG. 4C.

Being of different heights, one of the claimed fins of each pair can operate as pre-cutter (fins 72) and be configured to break into the vertebral body, whereas the second fin of each pair can operate as a main cutter and be configured to enlarge the recess and give it the final shape. This claimed configuration provides for a much safer and better creation of recesses into the end plates of the vertebral bodies. Further, apart from putting less strain on the vertebral bodies, the pairing of fins in the claimed configuration allows for a reduction in wear, thus providing long-term precision of the instrument.

Nothing in Michelson teaches or suggests such a configuration. All of the fins illustrated in Michelson have the same height relative to one another, and are not configured in oppositely arranged pairs.

Accordingly, since Michelson does not disclose every element required by the claims, the rejection of claim 23, and those depending thereon, should be withdrawn.

In view of the above, early action allowing claims 23-25 and 32-34 is solicited.

In the event the Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **246472010200**.

Dated: February 17, 2009

Respectfully submitted,

By Bradley J. Meier  
Bradley J. Meier  
Registration No.: 44,236

Morrison & Foerster LLP  
1650 Tysons Blvd, Suite 400  
McLean, Virginia 22102  
Telephone: (703) 760-7735  
Facsimile: (703) 760-7777

attachments

## APPENDIX

Atty Docket No.: 246472010200

Inventor: Helmut D. LINK et al.

Application No.: 35 USC 371 application of  
PCT/EP2005/001956

Filing Date: August 18, 2006

Title: CERVICAL INTERVERTEBRAL DISC PROSTHESIS COMPRISING AN ANTI-  
DISLOCATION DEVICE AND INSTRUMENTS

Documents Filed:

Transmittal Letter to the United States Designated-Elected Office (3 pages)

Copy of International Application (31 pages)

Application Data Sheet (3 pages)

English Translation of International Application (18 pages), Drawings (18 pages)

Designation of Record Attorney (1 page)

Oath or Declaration (3 pages)

Assignment and Recordation Form, Cover Sheet (3 pages)

PCT/ISA/210

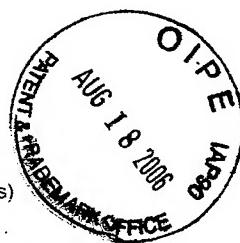
Information Disclosure Statement Form PTO/SB/08a/b (3 pages) 8 references

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